

REMARKS

I. STATUS OF APPLICATION

No claims have been added or canceled. Therefore, claims 1-38 are pending in the present Application. Claims 26-38 stand withdrawn from consideration.

Claims 1-25 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-6 of co-pending Application 11/072,382 ("the '382 application").

Claims 1-25 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-25 of co-pending Application 10/523,942 ("the '942 application").

Claims 1-20 stand rejected under 35 USC § 102(b), as being anticipated by either U.S. Patent 4,986,496 to Marentic *et al.* ("Marentic") or U.S. Patent 5,508,084 to Reeves *et al.* ("Reeves").

Claims 20-25 stand rejected under 35 USC § 103(a), as being unpatentable over Marentic or Reeves.

II. PROVISIONAL DOUBLE-PATENTING REJECTIONS

Claims 1-25 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-6 of the '382 application. Claims 1-25 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting, as being unpatentable over claims 1, 2, and 4-25 of the '942 application.

Applicant notes these provisional rejections, which will be taken up in due course upon allowance of either the '382 application or the '942 application.

III. 35 USC § 102 REJECTIONS

Claims 1-20 stand rejected under 35 USC § 102(b), as being anticipated by either Marentic or Reeves. Applicant respectfully traverses the rejection for at least the reasons set forth below.

A. The Office must identify wherein each and every facet of the claimed invention is disclosed in the applied reference

As the Office well knows, "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."¹ The Office, however, has failed its burden. The Office's entire discussion of the rejection of claims 1-20 consists of a single paragraph:

*Both references disclose a three-layered skin material that includes a decorative layer, an anti-slip layer there over [sic] with an adhesive layer on the backside of the decorative layer. Refer to figure 9 and the corresponding text thereto in Marentic et al. Refer to figures 2e-3c along with the corresponding text thereto in Reeves et al.*²

The Office's discussion fails to address many "facets of the claimed invention," for example:

Claim 1:
"the anti-slip layer having a surface finish having a high coefficient of friction so as to restrict movement of the handheld electronic device relative to a contact surface" and "the skin is selectively shaped to conform to the contours, shape, and components of the handheld electronic device"

¹ *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990).

² Detailed Action, p. 3, I. 20, through p. 4, I. 1.

- Claim 2: "the combined thickness of the decorative layer and the anti-slip layer is less than about 0.5 millimeters"
- Claim 3: "the decorative layer and the anti-slip layer are transparent"
- Claim 4: "the decorative layer includes a graphical image that is visible through the anti-slip layer"
- Claim 5: "the surface finish is smooth"
- Claim 6: "the surface finish is a matte finish"
- Claim 7: "the surface finish is a glossy finish"
- Claim 8: "the surface finish is a suede finish"
- Claim 9: "the surface finish is non-smooth"
- Claim 10: "the surface finish includes upraised members"
- Claim 11: "the surface finish includes inwardly depressed members"
- Claim 12: "the surface finish includes a combination of upraised members and depressed members"
- Claim 13: "the surface finish includes at least two of the following features: (a) upraised bumps; (b) depressed bumps; (c) upraised ridges; (d) depressed ridges; and (e) void spaces"
- Claim 14: "the decorative layer is printed label stock"
- Claim 15: "the anti-slip layer is formed of a compressible material such that the anti-slip layer provides shock absorption"
- Claim 16: "the anti-slip layer is polarized such that an image on the decorative layer changes when viewed from different angles"
- Claim 17: "the anti-slip layer is formed from liquid silicone resin"
- Claim 18: "the anti-slip layer is formed from thermoplastic rubber"
- Claim 19: "the anti-slip layer is formed from cured elastomeric film"

Claim 20: "a first portion" and "at least one additional portion"

Even though the Office explicitly alleges that both Marentic and Reeves disclose a "skin material that includes a decorative layer, an anti-slip layer there over with an adhesive layer on the backside of the decorative layer," the Office fails to indicate which elements of Marentic and which elements of Reeves correspond to the material and the layers. Such a description leaves Applicant to guess as to which elements of Marentic and Reeves are construed by the Office to be the claimed elements. The Office's allegation is little more than a bald allegation that Marentic and Reeves anticipate the invention set forth in claims 1-20, which is improper.

Because the Office fails to indicate wherein Marentic and Reeves these claimed limitations can be found, the rejection of claims 1-20, as being anticipated by Marentic or Reeves is *prima facie* deficient. "It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office."³

For at least this reason, the rejection of claims 1-20 is improper and should, therefore, be withdrawn.

B. Marentic fails to anticipate claims 1-20

Each of independent claims 1 and 20 recite "an anti-slip layer." While the Office has failed to specifically denote which element of Marentic is the claimed anti-slip layer, it is believed that Marentic's layer 18 is construed by the Office as the claimed anti-slip

³ *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) quoting *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1788-89 (Bd. Pat. App. & Int. 1987).

layer. It should be noted, however, that Applicant does not construe Marentic's layer 18 as being the claimed anti-slip layer. Rather, Applicant respectfully asserts that Marentic fails to disclose in any way that its layer 18 is an anti-slip layer. Marentic is related to "the reduction of drag caused by fluids...flowing across surfaces," and more particularly to "articles which can be applied to surfaces to reduce such drag."⁴ Marentic teaches that its conformable sheet material "employs a patterned first surface to significantly reduce drag caused by fluid flowing over the surface of a body to which the sheet has been applied."⁵ Marentic's layer 18 includes the "patterned first surface." Nothing in Marentic even remotely suggests that layer 18 is an anti-slip layer, as required by the rejected claims. Specifically, the portion of Marentic referred to by the Office in the present action, *i.e.*, the text corresponding to Figure 9, fails to disclose any anti-slip layer. Thus, Marentic fails to disclose every limitation of the rejected claims in the same relationships to one another as set forth in the claims.

For at least these reasons, Marentic fails to anticipate the present invention, as set forth in claims 1 and 20. Claims 2-19 depend from claim 1. Accordingly, Marentic fails to anticipate the present invention, as set forth in claims 1-20.

C. Reeves fails to anticipate claims 1-20

Each of independent claims 1 and 20 recite "an anti-slip layer...having a high coefficient of friction so as to restrict movement of the handheld electronic device relative to a contact surface." While the Office has failed to specifically denote which element of Reeves is the claimed anti-slip layer, it is believed that Reeves' control layer

⁴ Marentic, col. 1, ll. 3-6.

⁵ Marentic, col. 2, ll. 5-8.

19 is construed by the Office as the claimed anti-slip layer. It should be noted, however, that Applicant does not construe Reeves' control layer 19 as being the claimed anti-slip layer. Rather, Applicant respectfully asserts that Reeves' control layer 19 does not "restrict movement of [a] handheld electronic device relative to a contact surface," as required by claims 1 and 20. Reeves is concerned with "articles...which are useful as a pad over which hand-held pointing devices may traverse,"⁶ i.e., a mouse pad. Reeves is particularly directed to mouse pads that are for use with "track ball" mice.⁷ Reeves then teaches:

A mouse will typically have one or more mouse buttons accessible to the user which the user may depress. In some cases, mouse buttons may be depressed simultaneously with the movement of the mouse across the surface, a procedure commonly known as "dragging." Dragging lets the user select a portion of the screen or move objects around the screen. In some mice of the type described, moving the mouse slowly results in small movements of the pointer, while moving the mouse faster results larger pointer movements

(emphasis added).⁸ While it is desirous for Reeves' article to provide "good aggressive grab to the track ball,"⁹ the article allows the sole of a mouse to be freely moved across its control surface 19 in order to operate properly. Conversely, claims 1 and 20 require the claimed anti-slip layer "to restrict movement of the handheld electronic device relative to a contact surface." In other words, the claimed anti-slip layer restricts movement relative to a contact surface, while Reeves' control surface 19 allows movement relative to a contact surface. Thus, utilizing Reeves' control surface 19 as

⁶ Reeves, col. 1, ll. 14-16.

⁷ Reeves, col. 1, ll. 18-33.

⁸ Reeves, col. 1, ll. 34-43.

⁹ Reeves, col. 2, ll. 40-43.

the claimed anti-slip layer would not “restrict movement of a handheld electronic device relative to a contact surface,” as required by claims 1 and 20.

Because Reeves fails to disclose every limitation of the rejected claims in the same relationships to one another as set forth in the claims, Reeves fails to anticipate the present invention, as set forth in claims 1 and 20. Claims 2-19 depend from claim 1. Accordingly, Reeves fails to anticipate the present invention, as set forth in claims 1-20.

For at least these reasons, it is respectfully requested that the rejection of claims 1-20 under 35 USC § 102(b), as being anticipated by Marentic or Reeves, be reconsidered and withdrawn.

IV. 35 USC § 103 REJECTIONS

Claims 20-25 stand rejected under 35 USC § 103(a), as being unpatentable over Marentic or Reeves. The Office alleges that “[t]he primary references teach the invention substantially as recited except for multiple sections.”¹⁰ As discussed *supra* concerning the 35 USC § 102(b) rejection of claim 20, neither Marentic nor Reeves teach the claimed anti-slip layer. Note that claims 21-25 depend from claim 20. Thus, the present invention, as set forth in claims 20-25, cannot be rendered obvious by either Marentic or Reeves. For example, because the claimed anti-slip layer has not been *prima facie* shown to be in the prior art, the claimed invention cannot be a result of combining prior art elements according to known methods to yield predictable results. Moreover, because the claimed anti-slip layer has not been *prima facie* shown to be in the prior art, the claimed invention cannot be a simple substitution of one known

¹⁰ Detailed Action, p. 4, II. 20-21.

element for another to obtain predictable results. Furthermore, because the claimed anti-slip layer has not been *prima facie* shown to be in the prior art, the claimed invention cannot be a use of a known technique to improve similar devices in the same way. Because the claimed anti-slip layer has not been *prima facie* shown to be in the prior art, the claimed invention cannot be construed as applying a known technique to a known device ready for improvement to yield predictable results. Because the claimed anti-slip layer has not been *prima facie* shown to be in the prior art, the claimed invention cannot be construed as choosing from a finite number of identified, predictable solutions with a reasonable expectation of success. Furthermore, because the claimed anti-slip layer has not been *prima facie* shown to be in the prior art, the claimed invention cannot be a known work in one field of endeavor that prompts variations of it in either the same field or a different one based on design incentives or other market forces. Finally, the Office has provided no teaching, suggestion, or motivation in the prior art that would have lead one of ordinary skill in the art to modify either Marentic or Reeves to arrive at the claimed invention. Rather, it is respectfully submitted that any attempt to assert that either Marentic or Reeves discloses or suggests the claimed invention as a whole is necessarily based on an improper use of hindsight using Applicant's disclosure as a roadmap.

For at least these reasons, it is respectfully requested that the rejection of claims 20-25 under 35 USC § 103(a), as being unpatentable over Marentic or Reeves, be reconsidered and withdrawn.

V. DISTINCTIONS, OTHER THAN THOSE DISCUSSED, MAY EXIST

Note that Applicant has merely discussed example distinctions from the various references cited by the Office. Other distinctions may exist and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal. By not responding to the additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The remarks provided above are sufficient to overcome the Office's rejections.

CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned at (817) 578-8616 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

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